



PATENT
Attny Dkt No.: 11032-3067

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: MERRIMAN, Dwight Allen et al.

Appl'n No.: 10/798,342

Group Art Unit: 3627

Filing Date: 12 March 2004

Examiner: Laneau, Ronald

For: METHOD OF DELIVERY, TARGETING, AND
MEASURING ADVERTISING OVER NETWORKS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejections in the Office action mailed March 18, 2005 ("final Office action") in connection with the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

The review is requested for at least the following reasons:

ARGUMENTS

Claims 1-22 are pending in the application. Claim 1 is the sole independent claim, and is reproduced as follows:

1. **(Original)** A method for advertising, comprising:

receiving an advertisement request from a user node, wherein said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node; and

selecting, in response to said advertisement request, an advertisement based upon stored information about said user node.

Wexler Does Not Disclose Selecting an Advertisement in Response To an Advertisement Request

The Office has rejected claims 1-15 and 19-22 under 35 U.S.C. 102(e) as being anticipated by Wexler (U.S. Patent No. 5,960,409). Anticipation cannot occur in the instant application, however, for at least the reason that Wexler fails to disclose selecting an advertisement in response to an advertisement request as claimed.

Independent claim 1 recites, in part, “selecting, in response to said advertisement request, an advertisement based upon stored information about said user node.”

Foremost, the Office bases its support in Wexler for this limitation upon a clear factual deficiency. The Office merely cites to disclosure in Wexler of “a banner wherein a user can click to access an advertiser web site through a third party.” Final Office action, page 5, para. 5. Such accessing of an advertiser web site by a user clicking on a banner does not involve an advertisement request, much less selection of an advertisement in response to an advertisement request as claimed.

Further, in contrast to the claimed invention, the third party accounting and statistical service of Wexler merely “accumulates and tabulates statistical information including the number of clicks on the advertiser's banner, and further provides data indicative of the

effectiveness of the banner publisher's Web page as an advertising medium." Wexler, col. 2, lines 57-61. Since the third party service of Wexler only provides accounting and statistical information and does not select ads, it cannot anticipate independent claim 1 of the present application.

Accordingly, as pending dependent claims 2-22 depend from and further limit their respective independent claim, Applicants respectfully maintain that all of the pending claims, for at least the reasons described above, are not anticipated by Wexler under 35 U.S.C. § 102.

The Claims Are Non-Obvious Over Wexler

The Office has rejected dependent claims 16-18 under 35 U.S.C. 103(a) as being unpatentable over Wexler. Applicants respectfully maintain that the Office does not establish a *prima facie* case of obviousness, because the suggestions or motivations provided by the Office action do not cure the deficiencies of Wexler (the 35 U.S.C. § 102 art) as explained above.

Accordingly, for at least the reasons described above, Applicants submit that all of the pending claims, independent and dependent, are non-obvious over Wexler under 35 U.S.C. § 103.

CONCLUSION

It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

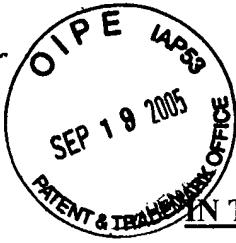
The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Dated: September 19, 2005


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STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:

Applicants thank Examiner Laneau for the courtesies extended at the personal interview on August 23, 2005, and provide this Statement of Substance of Interview in compliance with M.P.E.P. 713.04:

- (A) Exhibits. No exhibit / demonstration was shown / conducted.
- (B) Claims. The discussion was limited to the sole independent claim (claim 1).
- (C) Prior art. Wexler (U.S. Patent No. 5,960,409) was discussed.
- (D) Amendments. Not applicable.
- (E) Principal arguments by Applicants. Wexler does not teach or suggest selection an advertisement in response to an advertisement request as claimed.
- (F) Other matters. Applicants' representative discussed the limitations of claim 1, and apprised Examiner Laneau of the nature and status of the related applications.
- (G) No agreement reached. Although agreement was not reached at the interview, the Examiner expressed his intention to consider the arguments provided by Applicants' representative, and that further search may be warranted.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

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